

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

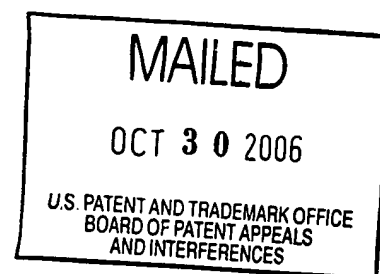
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JUNICHI TSUJI

Appeal No. 2006-2520
Application No. 09/802,895

HEARD: October 17, 2006



Before THOMAS, RUGGIERO, and SAADAT, **Administrative Patent Judges.**

RUGGIERO, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-9 and 14-26, which are all of the claims pending in this application.

The claimed invention relates to an image processing device and a printer for printing an image to recording material in which speech data representing speech associated with the image is input from a speech data input unit. A voice tone converter is utilized to subject the input speech data to tone conversion with the tone-converted speech being recorded on a recording material in association with the image.

Claim 1 is illustrative of the invention and reads as follows:

1. An image processing device for processing image data, comprising:

a speech data input and for inputting speech data associated with said image data for representing speech;

a voice tone convertor for subjecting said speech data to tone conversion; and

a speech data output unit for outputting said tone converted speech data in association with said image data.

The Examiner relies on the following prior art:

Hatada et al. (Hatada)	4,270,853	Jun. 02, 1981
Kinoshita	4,983,996	Jan. 08, 1991
Bell et al. (Bell)	5,276,472	Jan. 04, 1994
Leveque	5,495,468	Feb. 27, 1996
Nakamura et al. (Nakamura)	5,684,262	Nov. 04, 1997
Bernardi et al. (Bernardi)	5,692,225	Nov. 25, 1997
Spies	6,035,273	Mar. 07, 2000

Claims 1-9 and 14-26, all of the appealed claims, stand finally rejected under 35 U.S.C.

§ 103(a). As evidence of obviousness, the Examiner offers Bell in view of Nakamura with respect to claims 1, 2, 14, and 15, adds Leveque to the basic combination with respect to claims 3, 9, 16, and 26, adds Kinoshita to the basic combination with respect to claims 17 and 18, adds Hatada to the basic combination with respect to claim 19, and adds Bernardi to the basic combination with respect to claims 4-7, 20-22, and 24. In additional rejections under 35 U.S.C.

§ 103(a), claim 23 is rejected as being unpatentable over the combination of Bell, Nakamura, Bernardi, and Kinoshita, and claims 8 and 25 are rejected as being unpatentable over the combination of Bell, Nakamura, Bernardi, and Spies.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs² and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as recited in claims 1-9 and 14-26. Accordingly, we affirm.

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by Appellant have been considered in this decision. Arguments which

¹ The Appeal Brief was filed January 17, 2006. In response to the Examiner's Answer mailed April 5, 2006, a Reply Brief was filed May 30, 2006, which was acknowledged and entered by the Examiner as indicated in the communication dated June 23, 2006.

Appellant could have made but chose not to make in the Briefs have not been considered and are deemed waived [see 37 CFR § 41.37(c)(1)(vii)].

With respect to the Examiner's obviousness rejection of independent claim 1, Appellant's arguments in response assert a failure to set forth a prima facie case of obviousness since proper motivation for the proposed combination of the Bell and Nakamura references has not been established. After careful review of the disclosures of Bell and Nakamura, in light of the arguments of record, we are in general agreement with the Examiner's position as stated in the Answer. We find no persuasive arguments from Appellants that convince us of any error in the Examiner's assertion of obviousness based on the combination of Bell and Nakamura for all of the reasons articulated by the Examiner at pages 3-6 and 21-31 of the Answer.

In our view, the ordinarily skilled artisan would recognize and appreciate that the voice tone converter disclosed by Nakamura would serve as an obvious enhancement to the system of Bell, thereby improving the audio quality of Bell's recorded sound that is associated with a printed image. Although a primary focus of Appellant's arguments (Brief, page 10; Reply Brief, page 4) is that any tone conversion performed by Nakamura is not with respect to speech data that is associated with an image, we find clear evidence to the contrary in the disclosure of Nakamura. Although not mentioned by the Examiner, Nakamura discloses (column 7, line 66 through column 7, line 3) that other than the compact disc recording medium played on the playback device 1 (column 3, lines 43-46) to which speech input data is associated, the playback recording medium could be an optical video disc, clearly suggesting that tone converted speech data is indeed associated with reproduced images.

We also find to be unpersuasive Appellant's argument (Brief, page 11; Reply Brief, page 7) that the complex tone conversion features of Nakamura involving instrumentation and pitch adjustment would not be desirable in the photographic film environment disclosed by Bell. It is apparent to us from the Examiner's stated position (Answer, pages 23 and 24) that the Examiner is not suggesting the bodily incorporation of the device of Nakamura into the device of Bell. Rather, it is Nakamura's teaching of applying tone conversion to input speech data to improve audio quality that is relied on as a rationale for the proposed combination. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference....Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." See also In re Sneed, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983) and In re Nievelt, 482 F.2d 965, 967, 179 USPQ 224, 226 (CCPA 1973).

For the above reasons, since it is our opinion that the Examiner's prima facie case of obviousness based on the combination of Bell and Nakamura has not been overcome by any convincing arguments from Appellant, the Examiner's 35 U.S.C. § 103(a) rejection of claim 1, as well as claims 2, 14, and 15 not separately argued by Appellant, is sustained.

We also make the observation, referring to our earlier discussion of Nakamura, that Nakamura discloses, as presently recited in claims 1-3, an image processing device which processes image data, i.e., the playback image information from an optical video disk (column 7, line 67), speech data input (microphone 11) which inputs speech data associated with the playback image data, a voice tone converter 16 for subjecting the speech data to tone conversion, and a speech data output unit 5 which outputs tone converted speech data in associated with the

image data. Nakamura further provides for plural sets of tone mode information (column 4, lines 59-64) and for the output of tone converted speech which is a combination (15) of original speech (11) and tone conversion data (16).

In view of the above discussion and analysis of the disclosure of the Nakamura reference, it is our opinion that, although we found no error in the Examiner's proposed combination of Bell and Nakamura as discussed supra, the Bell reference is not necessary for a proper rejection of at least claims 1-3 since all of the claimed elements are in fact present in the disclosure of Nakamura. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of claims 3, 9, 16, and 26, we sustain this rejection as well. Initially, we find that the teachings of Leveque, relied upon by the Examiner as disclosing the generation of tone conversion data and the outputting of tone-converted speech data that is a combination of speech data before tone conversion and conversion data, are cumulative to those of Nakamura. At least in the manner broadly set forth by Appellant in claims 3, 9, 16, and 26, we find that Nakamura discloses the generation of conversion data in the tone converter block 16 as well as the output of tone converted speech data (at mixer 15) which is a combination of speech data before tone conversion (from microphone 11) and conversion data (from tone converter 16).

In view of the above discussion, since the Examiner's prima facie case of obviousness has not been overcome by any convincing arguments from Appellant, and since the Leveque reference is not needed for a proper rejection under 35 U.S.C. § 103(a), we sustain the Examiner's 35 U.S.C. § 103(a) rejection of claims 3, 9, 16, and 26 based on the combination of Bell and Nakamura alone.

We also sustain the Examiner's obviousness rejection of claims 17 and 18 in which the optical printing teachings of Kinoshita are added to the combination of Bell and Nakamura. Appellant has not argued this rejection separately but, instead, relies on arguments made previously with respect to the Examiner's combination of Bell and Nakamura as applied against claim 1, which arguments we found to be unpersuasive as discussed supra.

The Examiner's 35 U.S.C. § 103(a) rejection of claim 19 based on the combination of Bell, Nakamura, and Hatada is also sustained. As explained at page 36 of the Answer, the Examiner's position does not suggest the bodily incorporation of the instant printing features of Hatada into the device of Bell as modified by Nakamura. Instead, it is Hatada's teaching of magnetic recording of speech data that is relied on for the proposed combination. We find no persuasive arguments from Appellant that convince us of any error in the Examiner's position as articulated in the Answer (page 13).

We further sustain the Examiner's obviousness rejection of claims 4-7, 20-22, and 24 based on the combination of Bell, Nakamura, and Bernardi. We find no error in the Examiner's

² The Board may rely on less than all of the references applied by the Examiner in an obviousness rationale without designating it as a new ground of rejection. In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); In re Boyer, 363 F.2d 455, 458, n.2, 150 USPQ 441, 444, n.2 (CCPA 1966).

finding of the obviousness to the skilled artisan of adding a speech/text converter as taught by Bernardi to the device of Bell as modified by Nakamura to thereby, inter alia, permit accurate printed annotations of speech data as explained by the Examiner. To whatever extent Appellant is correct in the assertion (Brief, pages 19 and 20; Reply Brief, page 11) that Bernardi recognizes the problem that original recorded speech may be difficult to understand aurally, we do not find that this “teaches away” from a combination with Bell and Nakamura. In our view, the combined system of Bell and Nakamura results in tone converted original speech with improved aural quality which would be obviously enhanced by use of a speech/text converter such as taught by Bernardi enabling accurate annotations of speech data.

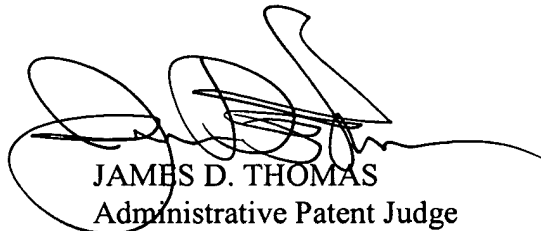
Lastly, we also sustain the Examiner’s U.S.C. § 103(a) rejections of claim 23, based on the combination of Bell, Nakamura, Bernardi, and Kinoshita, and of claims 8 and 25, based on the combination of Bell, Nakamura, Bernardi, and Spies. Appellant has made no separate arguments as to patentability of these claims and, instead, relies on arguments made with respect to claim 1, which arguments we found to be unpersuasive for all of the previously discussed reasons.

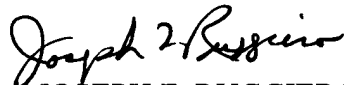
In summary, we have sustained the Examiner’s 35 U.S.C. § 103(a) rejections of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-9 and 14-26 is affirmed.


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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective September 13, 2004).

AFFIRMED


JAMES D. THOMAS
Administrative Patent Judge


JOSEPH F. RUGGIERO
Administrative Patent Judge


MAHSHID D. SAADAT
Administrative Patent Judge

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